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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,953	09/19/2001	Kazuo Suzuki	3190-010	9938

7590

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EXAMINER

KEMMERER, ELIZABETH

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,953

Applicant(s)

SUZUKI ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,6 and 11-15 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application, Amendments, And/Or Claims***

The amendment filed 03 March 2003 (Paper No. 14) has been entered in full. The sequence listing submitted with the response was found to be free of errors and has been entered into the file. Claims 1-15 are pending and under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Withdrawn Objections And/Or Rejections***

The rejection of claims 1-4 and 8-10 under 35 U.S.C. § 101 as reading on products of nature as set forth at pp. 2-3 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of the amended claims.

The rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, as set forth at pp. 3-4 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of the amended claims.

The rejection of claims 1-10 under 35 U.S.C. § 112, first paragraph, regarding enablement, as set forth at pp. 4-7 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of the amended claims.

The rejection of claims 1-10 under 35 U.S.C. § 112, first paragraph, regarding adequate written description, as set forth at pp. 7-8 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of the amended claims.

The rejection of claims 1-4 and 6-10 under 35 U.S.C. § 102(b) as set forth at pp. 8-9 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of the amended claims.

The indication of allowable subject matter at pp. 9-10 of the previous Office Action (Paper No. 13, 03 December 2002) is *withdrawn* in view of newly discovered prior art.

### ***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 requires the entire sequence of SEQ ID NO: 2. Dependent claim 2 requires only part of this sequence, amino acids 19 to 151 of SEQ ID NO: 2. Thus, claim 2 defines fewer amino acid positions than claim 1, and fails to further limit claim 1.

Claim 7 is objected to because of the following informalities: Claim 7 recites "SEQ ID No." whereas "SEQ ID NO." should be recited instead. Appropriate correction is required.

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**35 U.S.C. § 102**

Claims 1-4 and 8-10 rejected under 35 U.S.C. 102(b) as being anticipated by KR97065715-A (published 13 October 1997). [An English translation of this document is currently being prepared and will be forwarded to Applicant as soon as it is ready.]

KR97065715-A discloses a composition comprising a protein of SEQ ID NO: 1 (see p. 3, top and bottom figures). Although KR97065715-A does not teach that the protein as activity on bones, the phrase "bone resorption inhibitor composition" is interpreted as an intended use, and thus not given patentable weight in this art rejection. Furthermore, the bone resorption activity recited in the claims would be inherent to the prior art compound, as it is exactly the same compound.

**Conclusion**

Claims 5-6 and 11-15 are allowable. Claims 1-4 and 7-10 are not allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number is (703) 308-2673. The examiner can normally be reached on Mon. - Thurs., 6:30 to 4:00, and alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne L. Eyler, Ph.D. can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



ECK  
April 21, 2003

ELIZABETH KEMMERER  
PRIMARY EXAMINER